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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,615

08/29/2006

Jacques Thilly

8121-82022-01

7423

24197 7590 03/16/2010

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EXAMINER

CHIN, HUI H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/16/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,615	<b>Applicant(s)</b> THILLY ET AL.	
	<b>Examiner</b> HUI CHIN	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/31/2006, 1/29/2010</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-18, are drawn to an elastomer material.

Group II, claims 19-28, are drawn to a vial and the procedure of using this vial.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I and Group II did not have a common inventive feature: the elastomer material cited in claim 1 is not novel (see Py US 2003/0088216).

During a telephone conversation with Kevin Hayes on 3/5/2010 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-28 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The usage of trademarks will cause indefiniteness because the content of the trademarks can change with time.

Claims 5, 7, 8 and 12-14 are rejected because the claims contain trademarks.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 9, 12-14 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Py (US 2003/0088216).

Py discloses a resealable stopper wherein the stopper is formed of at least one of a thermoplastic and elastomeric material (claim 3). The elastomeric material possesses the claimed absorption coefficient since it is the same material as in the claimed invention.

The limitations of claim 2 can be found in Py at claim 22, where it discloses the colorant.

The limitations of claim 3 can be found in Py at claim 3, where it discloses the thermoplastic and elastomeric material possessing the same melting point because it is substantially the same material as in the claimed invention.

The limitations of claim 4 can be found in Py at [0041] and claim 15, where it discloses the styrene block copolymer.

The limitations of claim 5 can be found in Py at claim 15 and [0041], where it discloses the material.

The limitations of claim 6 can be found in Py at claim 22, where it discloses the colorant.

The limitations of claim 7 can be found in Py at claim 22, where it discloses the grey colorant.

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The limitations of claim 9 can be found in Py at [0046], where it discloses the olefin such as ENGAGE or EXACT.

The limitations of claims 12-14 can be found in Py at claims 3, 15 and 22, where it discloses the material.

Claims 16-18 are inherent properties.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under U.S.C. 103(a) as being unpatentable over Py (US 2003/0088216) in view of Asthana et al. (US 2003/0175488).

The disclosure of Py is adequately set forth in paragraph 4 and is incorporated herein by reference.

However, Py is silent on the specific mixture of pigments.

Asthana et al. disclose a substrate layer using combination of colorants such as Green 7, White 6, Blue 29 and Black 7 to provide required color which does not degrade at high temperatures ([0046], [0047]). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to make the composition with the specific mixture of pigments with the expected success.

7. Claims 10 and 11 are rejected under U.S.C. 103(a) as being unpatentable over Py (US 2003/0088216) in view of DeGraff et al. (US Patent 3,650,664).

The disclosure of Py is adequately set forth in paragraph 4 and is incorporated herein by reference.

However, Py is silent on the specific amount of pigments.

DeGraff et al. disclose a color concentrate with 12 or 26 parts of pigment in ethylene vinyl acetate copolymer to provide the required stable color (Examples 1 and 2). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the composition with the specific amount of pigments with the expected success.

8. Claim 15 is rejected under U.S.C. 103(a) as being unpatentable over Py (US 2003/0088216).

The disclosure of Py is adequately set forth in paragraph 4 and is incorporated herein by reference.

Py discloses a stopper comprises a thermoplastic body with a predetermined wall thickness and the predetermined power is with the range of about 8 to 10 Watts (claims 14 and 22). Py is silent on the specific thickness. The relative thickness will determine the properties of the elastomer. The higher the thickness the less the laser power can pass through. The case law has held

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that “a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation”. *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to achieve the relative thickness of the elastomer via the routine optimization process and thereby obtain the present invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUI CHIN whose telephone number is (571)270-7350. The examiner can normally be reached on Monday to Friday; 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->



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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ling-Siu Choi/  
Primary Examiner, Art Unit 1796

/HC/